

Application No. 10/773,549
Responsive to Office action of August 24, 2005

page 2
September 9, 2005

Moreover, because of a mistake, the Examiner rescinded a prior two-way Restriction Requirement, dated **May 04, 2005**, in which restriction was required between:

- i. apparatus Claims 1 – 15 and 19 – 26 of Group I; and
- ii. method Claims 16 – 18 of Group II.

Applicant traversed the prior Restriction Requirement and made a provisional election of apparatus Claims 1 – 15 and 19 – 26 of Group I for examination on the merits.

a. Traverse of Restriction Requirement mailed on August 24, 2005 and Provisional Election of Group I

The Applicant respectfully traverses the Restriction Requirement and requests reconsideration and withdrawal of the Restriction Requirement. Pursuant to 37 C.F.R. §1.143, Applicant makes a provisional election of the apparatus Claims 1 – 15 of Group I for examination on the merits.

b. Non-Elected Claims Withdrawn Subject to Reinstatement

Pursuant to 37 C.F.R. §1.142(b), the non-elected method Claims 16 – 18 of Group II and the non-elected apparatus Claims 19 – 26 of Group III are withdrawn from consideration, subject however to reinstatement in the event the Restriction Requirement is withdrawn or overruled.

Application No. 10/773,549
Responsive to Office action of August 24, 2005

page 3
September 9, 2005

ARGUMENT

a. Reasons for Traverse by Applicant - Claims of Group II

(i) In the present Office Action, the Examiner states that the inventions of **Group I and Group II** are related as process of making and process of using the product and that the use as claimed cannot be practiced with a materially different product. Therefore, since the product is not allowable, restriction is proper between the method of making and the method of using (MPEP § 806.05(i)). As previously argued in response to the prior two-way Restriction Requirement dated **May 04, 2005**, Applicant respectfully disagrees with the Examiners characterization of the claims of **Group I and Group II** as being categorized as process of making and process of using the product as set forth in MPEP § 806.05(i).

First, MPEP § 806.05(i) is worded in the conjunctive and requires the Examiner to find claims to all three categories in order for restriction to be proper. As stated in MPEP § 806.05(i), "Where an application contains claims to a product, claims to a process specially adapted for ... making the product, and claims to a process of using the product ... applicant may be required to elect either (A) the product and process of making it; or (B) the process of using." However, a careful review of **Claims 1 – 15 of Group I** clearly shows that those claims are directed to an apparatus. The same is true of **Claims 19 – 26 of Group III**. Therefore, all three categories are not present in the claims of the present application because only two categories of claims are present (apparatus claims 1 – 15 and 19 – 26 and method of making claims 16 – 18). Accordingly, the Examiners restriction requirement under MPEP § 806.05(i) is not proper and ought to now be withdrawn.

Second, **Claims 16 – 18 of Group II** are directed to a method of making only. Consequently, the requirement that claims be to a process of using are not met because the present application does not include claims to a process of using! Accordingly, there can be no election of either "(A) the product and process of making it" or "(B) the process of using" since there are no claims directed towards "(B) the process of using." Therefore, restriction is not proper per MPEP § 806.05(i) and the

Application No. 10/773,549
Responsive to Office action of August 24, 2005

page 4
September 9, 2005

restriction requirement ought to now be withdrawn and method Claims 16 – 18 of Group II should be examined on the merits along with apparatus Claims 1 – 15 of Group I.

b. Reason for Traverse by Applicant - Claims of Group III

(i) Applicant respectfully traverses the Examiners reasons for requiring restriction between apparatus claims of Group I and Group III. The invention in the apparatus claims of Group III do not have a different function than the invention in the apparatus claims of Group I. Both Groups I and III are directed to memory devices and the function of those memory devices is to store data as a plurality of resistive states (see Claims 1 and 19). Accordingly, Groups I and III have similar functions, that is, to store data. The Examiner, in imposing the restriction requirement, did not state how the functions are different such that the inventions Groups I and III present independent and unrelated inventions. (MPEP § 808.01)

(ii) Moreover, MPEP §808.01 and form paragraph 8.20.02 require a showing by the Examiner that the inventions Groups I and III are “unrelated inventions” if it can be shown that *they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects*. Clearly, the claims of Groups I and III as disclosed in the present application do not meet the above requirements for proper restriction per MPEP §808.01 and form paragraph 8.20.02 because they do not have different modes of operation, do not have different functions, do not have different effects, and are disclosed as being capable of use together.

Therefore, restriction is not proper in accordance with MPEP §808.01 and the restriction requirement ought to now be withdrawn and apparatus Claims 19 – 26 of Group III should be examined on the merits along with apparatus Claims 1 – 15 of Group I.

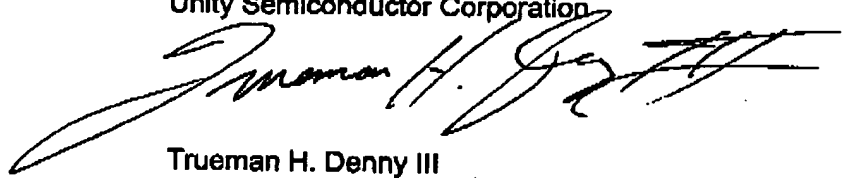
Application No. 10/773,549
Responsive to Office action of August 24, 2005

page 5
September 9, 2005

CONCLUSION

Applicant respectfully requests reconsideration and withdrawal of the **Restriction Requirement** mailed on **August 24, 2005**. Should the Examiner believe that a telephone conference would expedite the prosecution of this application the undersigned can be reached at (408) 737-7200 x124.

Respectfully submitted,
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